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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/554,047 | 12/19/97 | GARRISON | 33500-00001 |

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LM21/0520

| EXAMINER | |
|-------------------------|--------------|
| ROBINSON BOYCE, A | |
| <i>restarted period</i> | |
| ART UNIT | PAPER NUMBER |
| 2765 | 5 |

DATE MAILED: 05/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 087994,047 | 12/19/97 | GARRISON | D 33500-00001 |

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LM02/0405

EXAMINER

ROBINSON BOYCE, A

ART UNIT

PAPER NUMBER

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DATE MAILED: 04/05/99

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/994,047

Applicant(s)
Garrison et al.

Examiner
Akiba Robinson-Boyce

Group Art Unit
2765



☒ Responsive to communication(s) filed on Dec 19, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. (SUBSTITUTE)

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 5, 19 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "accessing" in claims 5, 19 and 27 is a relative term which renders the claim indefinite. The term "accessing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because of the use of the term "accessing", the claim and therefore the scope of the invention is unclear.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-4, 6-18, and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight et al. (U.S. Patent 5,383 vb,113) in further view of Pintsov et al. (U.S. Patent 5,612,889).

As per claim 1, Kight et al. discloses a computer implemented system which uses the methods of:

establishing a database including payee records (Col. 2, lines 40-41);

receiving a payor's payment information (Col. 2, lines 41-45);

processing the payment information (Col. 2, lines 5-11)
^{col 1 0 66- + 47-49}

accessing the database to locate a payee record (Col. 4, lines 23-26)

Kight et al. fails to teach the steps of identifying and corresponding to an eleven digit zip code. However, Pintsov et al. discloses a mail processing system which shows the step of processing mail information to identify an eleven digit zip code (Col. 7, lines 49-52). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to process the payment information to identify and 11 digit zip code for a payee because in order to deliver the payment to

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the correct entity regardless of any changes made, one would need to have some kind of identifier which would make the payment destination distinguishable.

As per claims 2, 17, and 25, Kight et al. discloses a method where:

the payment information processed by the processing step includes a portion of a payee's name and a portion of payee address (Col 2., lines 45- 46).

As per claim 3, both Kight et al. and Pintsov et al. fail to teach that payment information processed by the processing step includes a portion of a payee's city and a portion of a payee's state. Official notice is taken that it is old and well known in the payment processing art to include a portion of the city and state of the payee into the payment information especially if the payment information comprises a portion of the payee's address. It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to include a portion of the payee's city and a portion of a payee's state in order to complete the address portion of the payment information.

As per claims 4, 18 and 26, Kight et al. discloses a method where:

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the data base is accessed (Col. 4, lines 23-26) using a portion of a payee name extracted from the payment information (Col. 2, lines 45-46).

the payee record further corresponds to the portion of the payee name (Col. 2, lines 45-46).

Kight et al. fails to teach that the eleven digit zip code is used to access the payee record. However, Pintsov et al. discloses a system where there is a unique code that identifies the delivery address which consists of eleven digits (Col. 11, lines 26-29 and lines 49-51). It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to use the eleven digit zip code to access the payee record because the code identifies where the payment should be made and is associated with a specific payee.

As per claim 6, Kight et al. discloses the steps of:

making a payment to the payee after locating the payee record (Col. 2, lines 12-15).

As per claim 7, Kight et al. discloses a method wherein:

the payment is an electronic payment (Col. 8, lines 52-54).

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As per claims 8, 14 and 20, Kight et al. discloses a method wherein:
the payment information includes...(Col. 2, lines 65-67);
verifying the account number...and transforming the verified...(Col. 3, lines
4-9)

Kight et al. fails to teach the following steps:

the database further includes alteration rules...
and validation rules...
processing the payment information to verify...

However, Pintsov et al. discloses a system where "The unique identification includes...an error correction code" (Col. 10, lines 61-65). Pintsov et al. also discloses a validation process (Col.11, lines 56-67 and Col.12, lines 1-4). It would have ben obvious to one of ordinary skill in the art at the time of the applicants invention to include validation rules and alteration rules into a payment processing system in order to make sure the correct payment is appropriately directed.

As per claims 9, 15, 21 and 24, Kight et al. fails to teach the following method wherein:

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the payee has a plurality of remittance centers...

processing the account number...

directing payment...

However Pintsov et al. discloses a mail processing system where there are a plurality of delivery points, the delivery point postal code is processed to identify a single delivery point and the delivery is directed to that delivery point (Col.11, lines 39-51). It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to incorporate Pintsov et al.'s delivery point concept into Kight et al.'s payment processing system because in order for a payment to go to the correct remittance center if there are a plurality of remittance centers, a single remittance center must be identified.

As per claims 10-12, 16 and 22, Kight et al. discloses a computer implemented process comprising:

receiving ^{processing} name...associated with a merchant (Col. 3, lines 32-35);

accessing a database...(Col.4, lines 5-7).

a storage device...(Col.5, lines 13-14);

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a data input...(Col.2, lines 49-51);

a processor... (Col.4, lines 30-33).

processor is further configured to retrieve payee records (Col. 4, lines 30-35).

computer readable storage...(Col. 5, line 13)

a computer program...(Col. 8, lines 39-43)

receive payment information ...(Col.3, lines 55-60)

process payment information...(Col.3, lines 63-66)

access a database if payee records...(Col. 4, lines 5-7).

a network (Fig. 1);

first station...(Col. 2, lines 40-51)

a second station...(Col. 4, lines 60-61 and lines 30-37).

Kight et al. fails to teach that processing is performed to identify an eleven digit zip code. However, Pintsov et al. (Col. 13, lines 55-59). It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to include the step of processing payment information to identify and eleven digit zip code because in order to deliver the payment to the correct entity regardless of any

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changes made, one would need to have some kind of identifier which would make the payment destination distinguishable.

As per claim 13, Kight et al. discloses that his system will:

direct a payment to the payee in accordance with the payment information

(Col. 2, lines 12-15).

As per claim 23, Kight et al. discloses a payment processing system, but fails to teach that his system comprises the following:

a database of alteration rules...

wherein the second station transforms the payor account...

However, Pintsov et al. discloses a mail processing system where the unique identification number has a specific format (Col. 10, lines 61-65). Pintsov et al. also discloses that mail address codes are transformed into new delivery point postal codes (Col. 7, lines 49-52). It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to include alteration rules indicating a format for account numbers because in order to make sure the payment

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is coming from the correct payor, one must comply to alteration rules if any changes were made.

Conclusion

An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached on (703) 305-9708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



ERIC W. STAMBER
PRIMARY EXAMINER

Application/Control Number: 08/994047

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Akiba Robinson-Boyce

Patent Examiner

Group Art Unit 2765

March 26, 1999